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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,454	10/12/2004	Xiao-Qi Zhou	7220206001-3222000	2358

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EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/511,454

Applicant(s)

ZHOU ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/25/07 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' amendment filed January 25, 2007 is acknowledged.

Claims 9, 39 and 43 are amended. Now, Claims 1-64 are pending.

2. Claim objection(s) in the previous Office Action (Paper No. 081906) is/are removed.

3. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 102 and 103

4. Rejection of Claims 1-10, 12-20, 25-44, 46-55 and 59-64 under 35 USC 102(e) as being anticipated by Matayabas (US 6 469 379) is maintained because the rejection is adequately set forth in paragraph 3[5] of Paper No. 081906. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 10, 1st and 2nd paragraphs), Examiner disagrees because the instant claims do not exclude the presence

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of any additional ingredients. Applicants are further reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)

For Applicants' argument (Remarks, page 10, last paragraph to page 11, 2nd paragraph), as mentioned in the previous Office action, the Si-H containing polydiorganosiloxane and the vinyl-containing polydiorganosiloxane have different solubility parameter. Since Matayabas' composition reads on the claimed one, both should possess the same characteristics. Applicants are reminded that phase separation and forming a protective barrier are not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)

5. Rejection of Claims 1-14, 16, 18-20, 22-23, 25-48, 50, 52-57 and 59-64 under 35 USC 102(b) as being anticipated by Mine (US 6 040 362) is maintained because the rejection is adequately set forth in paragraph 4[6] of Paper No. 081906. Applicant's arguments have been fully considered but

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they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 12, last paragraph to page 13, 2nd paragraph), as mentioned in the previous Office action, Mine's components A) and B) have different substituents, Examiner has a reasonable basis to believe that each has a different solubility parameter. Mine teaches the use of the composition be used in applications such as connecting heat-generating semiconductor elements to substrates (col. 8, lines 21-41), i.e., thermal interface applications. Applicants are reminded that phase separation is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)

6. Rejection of Claims 1-15, 17-26, 35-49 and 51-60 under 35 USC 102(b) as being anticipated by Theodore (US 4 292 225) is maintained because the rejection is adequately set forth in paragraph 5[7] of Paper No. 081906. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 14, last paragraph to page 15, 2nd paragraph), as mentioned in the previous Office action, Thoedore's vinyl/allyl group-containing polydiorganosiloxane and Si-H containing polydiorganosiloxane have different substituents, Examiner has a reasonable basis to believe that each has a different solubility parameter. Applicants are reminded that phase separation is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)

7. Rejection of Claims 1-5, 8-10, 12-15, 17-18, 25-39, 43-44, 46-49, 51-52 and 59-64 under 35 USC 102(b) as being anticipated by Hanson (US 5 950 066) is maintained because the rejection is adequately set forth in paragraph 5[8] of Paper No. 081906. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 16, last paragraph to page 17, 2nd paragraph), as mentioned in the previous Office action, Hanson teaches a thermal interface composition comprising polyorganosiloxane graft polymer of octadecene and methylsiloxane host that have different

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substituents, Examiner has a reasonable basis to believe that each has a different solubility parameter. Applicants are reminded that phase separation is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

In re Van Guens, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)

8. Rejection of Claims 21, 24, 55 and 58 under 35 USC 103(a) as being unpatentable over Matayabas, rejection of Claims 22 and 56 under 35 USC 103(a) as being unpatentable over Matayabas in view of Mine, rejection of Claims 21, 24, 55 and 58 under 35 USC 103(a) as being unpatentable over Mine, rejection of Claims 21 and 55 under 35 USC 103(a) as being unpatentable over Hanson and rejection of Claims 16 and 50 under 35 USC 103(a) as being unpatentable over Hanson in view of Matayabas'731 are maintained because the rejection is adequately set forth in paragraphs 9[10] to 13[14] of Paper No. 081906. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 17, last paragraph to page 18, 1st paragraph), Examiner disagrees because of the following reasons: First, Applicants are reminded that for these rejections under 35 USC 103(a),

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the disclosures of the corresponding primary references cited previously are properly incorporated into these rejections. Furthermore, Claims 1 and 35 are anticipated by the prior art, it is inadequate to further reject them under 35 USC 103(a). Second, Applicants are reminded that it is not necessary to have secondary references in obviousness-type rejections, and rejections based on single references are not necessarily anticipation-type.

For Applicants' argument (Remarks, page 18, 2nd paragraph), Examiner disagrees because the instant claims do not exclude the presence of any additional ingredients. Applicants are further reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In re Van Guens, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)

For Applicants' argument (Remarks, page 18, last paragraph to page 19, 1st paragraph), as mentioned in the previous Office action, the Si-H containing polydiorganosiloxane and the vinyl-containing polydiorganosiloxane have different solubility parameter. Since Matayabas' composition reads on the claimed one, both should possess the same characteristics. Applicants are reminded that phase separation and forming a protective barrier are not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into

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the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)


9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

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Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
April 10, 2007


Kuo-Liang Peng
Primary Examiner
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